

PATENT
Atty. Dkt. No. ROC920000071US1
MPS Ref. No.: IBM2k0071

REMARKS

This is intended as a full and complete response to the Office Action dated November 29, 2004, having a shortened statutory period for response set to expire on February 28, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1, 2, 4, 5, 8-19, 21, 22, 25-40, 42 and 45-63 are pending in the application. Claims 1, 2, 4, 5, 8-19, 21, 22, 25-40, 42 and 45-63 remain pending following entry of this response. Claims 1, 18, 35, 45-50, 53, 55, and 59 have been amended. Applicants submit that the amendments and new claims do not introduce new matter.

Claim Rejections - 35 U.S.C. § 112

Claims 46-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Examiner states that claims 46-63 are rejected because the specification does not have support for the subject matter of metadata. The claims have been amended to replace the term metadata with data. Accordingly, Applicants respectfully request withdrawal of the rejection.

Claim Rejections - 35 U.S.C. § 102

Claims 1-2, 4, 5, 8-15, 17-19, 21, 22, 25-32, 34-36, 38-42, 45, 46, 49, 50, 59, 60, 62 and 63 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Adar et al.* (US 6,493,702 B1, hereinafter "Adar"). Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim... *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

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MPS Ref. No.: IBM2k0071

In this case, *Adar* does not disclose "each and every element as set forth in the claim". Specifically, *Adar* does not disclose both a network address of a bookmarked document and source information which identifies a specific source, of a plurality of sources, at which a bookmark to the document was created.

The Examiner argues that *Adar* discloses source information which identifies a specific source, of a plurality of sources, at which a bookmark to a document was created at (Citing col. 1 line 67 to col. 2, line 4 and col. 2, lines 21-32). However, the cited passages are in fact only directed to bookmarks which contain URLs (See col. 1 line 67 to col. 2, line 4). The cited sections state that the bookmark may contain additional information such as the date and time of the users' most recent visit to the site and the collected number of visits (col. 2, lines 21-32). This information provides the user with the network address of the bookmark as well as when the bookmark was last visited. However, the users of *Adar* have no way of determining, from the bookmark file, the source at which the bookmark to the document was created.

In other words, none of the cited sections disclose source information which identifies a specific source, of a plurality of sources, at which a bookmark to the document was created, as claimed. Accordingly, the claims are believed to be allowable and Applicant's respectfully request withdrawal of the rejection.

With respect to claim 49, *Adar* does not disclose "each and every element as set forth in the claim". Examiner cites Fig. 2 and col. 12, lines 48-56 (describing Fig. 2) for the proposition that *Adar* discloses a data column (icons indicating popularity) having been created when the respective bookmark was bookmarked. However, as taught in *Adar*, the popularity of a bookmark cannot be determined until after users have had a chance to use the bookmark (See Col. 12, Lines 35-39, describing how the database, in determining popularity, periodically determines how many users already have a bookmark). Accordingly, *Adar* does not disclose a metadata column having been created when the respective bookmark address was bookmarked, as claimed.

Therefore, Applicants submit that claims 1-2, 4, 5, 8-15, 17-19, 21, 22, 25-32, 34-36, 38-42, 45, 46, 49, 50, 59, 60, 62 and 63 are patentable over *Adar*. Withdrawal of the rejection is respectfully requested.

PATENT
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Claim Rejections - 35 U.S.C. § 103

Claims 16, 33, 47, 48, 51-58 and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Adar*. Applicants respectfully submit that *Adar* has been overcome for the reasons given above. Accordingly, claims 16 and 23 are believed to be allowable and Applicants respectfully request withdrawal of the rejection.

Claim 37 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Adar* in view of *Smethers* (US 6,560,640 B2). Applicants respectfully submit that *Adar* has been overcome for the reasons given above. Thus, Applicants submit that the combination of *Adar* and *Smethers* has been overcome because the combination of *Adar* and *Smethers* does not teach, show, or suggest bookmark information entries comprising a bookmarked network address and corresponding source identifier information identifying a specific source, of a plurality of sources, at which the bookmarked network address was bookmarked. Accordingly, claim 37 is believed to be allowable and Applicants respectfully request withdrawal of the rejection.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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